



542-003.003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of :
Satoshi Mekata and Hiroshi Fujio :
Serial No. 10/018,515 : Examiner: Alton Nathaniel Pryor
Filed: December 13, 2001 : Group Art Unit: 1616
For: INTERMITTENT INJECTION AEROSOL PRODUCT FOR SKIN

Director
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Office Action of February 9, 2007,
please amend the above-referenced patent application as
follows:

*****If any fee and/or extension is required in addition to any enclosed herewith, please charge Account No. 23-0442.**

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REMARKS

This communication is in response to the Final Office Action of August 9, 2007 in which claims 22-24 are rejected.

The Office Action of August 9, 2007 practically repeats the arguments made in the Office Action of February 9, 2007. Arguments presented by the Applicant in the Amendment B received by the USPTO on May 11, 2007 are fully applied and some of these arguments are repeated herein in addition to response to Examiner's "Response to Arguments".

Claim 22 is rejected under 35 U.S.C. 112, first paragraph.

In the response to arguments of the Office Action of August 9, 2007 the Examiner stated that mentioning "product" or "composition" in claim 22 does not require the device to contain the "product" or "composition" "but instead informs an artisan that a "composition" or "product" may be present for the device's intended use.

The applicant continues to disagree with the Examiner. In addition to arguments presented in the Amendment B received by the USPTO on May 11, 2007, claim 22 not only mentions the "product" in preamble but also in the body of the claim as follows:

"Claim 22. An intermittent aerosol dispensing device for application of a product to skin of a human being, comprising

a cylinder adapted to be secured atop an aerosol can, said cylinder communicating with said product, pressurized

in said can, via a port;". Then this "product" is further recited in claim 22 of the present invention: "a pressure chamber adapted to receive pressurized product,".

It is unambiguously clear from claim 22 of the present invention that the "product" (which is equivalent to "aerosol product" or "composition") is pressurized in the can which is connected to the dispensing device and said "product" in the can is used for application to the skin. In that sense there is no way anybody can interpret claim 22 such that said "product" can be present or may not for the device's intended use. Thus said "product" absolutely has to be present as recited in claim 22, contrary to what is alleged by the Examiner.

Claim 22 was rejected under 35 U.S.C. 102 (b) as being unpatentable over Hiroshi (JP 11-342202; 12/14/99).

In addition to arguments presented in the Amendment B received by the USPTO on May 11, 2007, the applicant is of opinion that in the Office Action of August 9, 2008, the Office did not provide a proof that the reference of Hiroshi recites all embodiments recited in claim 22 of the present invention. The examiner simply listed the parts of Hiroshi alleging their equivalence to the parts recited in claim 22 of the present invention without proof or providing any details about their functionality in reference to embodiments of claim 22 of the present invention and showing that "the identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP 2131. Thus the burden of proof is on the Office to provide the evidence that Hiroshi discloses

complete details of the invention recited in claim 22, as required by the MPEP 2131 quoted herein. Clarification from the Office is requested.

But even incomplete evidence provided by the Examiner in the Office Action of August 9, 2007 is inaccurate, confusing and difficult to follow. For example, the Examiner stated on page 4, top 2 lines of the Office Action of August 9, 2007 that needle valve and first coil spring are both elements 7 of Hiroshi, which is not possible. Also piston 4 referred to by the Examiner is actually a valve 4 (see Paragraph 0003 of Hiroshi). Thus it is difficult to follow the limited evidence provided by the Office in the Office Action of August 9, 2007. Clarification from the Office is requested.

In "response to arguments" section of the Final Office Action of August 9, 2007, the Examiner stated that the "Functional language can add patentable significance to a claim, if it could be proven that the earlier invention could not have performed the instant function". The applicant disagrees with this approach. In particular, it should be proven the opposite, i.e., "that the earlier invention could have performed the instant function by "appropriate selection of a spring constant of said second coil spring" as recited in claim 22 of the present invention. In other words, the applicant is of opinion that the burden of proof is on the Office to show that the apparatus disclosed by Hiroshi can provide a ratio of an injection time to a stop time set to 0.1 to 5.0, when a valve is opened using appropriate selection of a spring constant of the second coil spring as recited in claim 22 of the present invention. Hiroshi does not talk or even

hint about ratio of an injection time to a stop time and the corresponding properties of the second coil spring in that regard in the disclosure at all.

No arguments in regard to claims 23 and 24 are presented by the Office, therefore the applicant does not respond to rejection of claims 23-24.

The objections and rejections of the Office Action of August 9, 2007 having been shown to be inapplicable, withdrawal thereof is requested and passage of all claims to issue is solicited.

Respectfully submitted,



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Date: 2/7/08

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